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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/089,901 06/03/98 SHOJI

M YAMAP0575US

EXAMINER

WM02/0907

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ART UNIT

PAPER NUMBER

2651

DATE MAILED:

09/07/01

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/089,901
Filing Date: June 03, 1998
Appellant(s): SHOJI ET AL.

Mark D. Saralino
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 2, 2001.

The grounds of rejection with respect to claims 1-20 under 35 USC 112 paragraph one are no longer maintained in this answer.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct, with exception to claims 1 –20 under 35 USC 112 paragraph one, because the rejection thereof is no longer maintained under 35 USC 112 paragraph one.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1 - 20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,508,995	Moriya et al	4-1996
5,341,360	Johann et al	8-1994
5,812,506	Pietrzykoski et al	9-1998
6,091,669	Nakane et al	7-2000
5,936,932	Nakane et al	8-1999
5,946,285	Nakane et al	7-2000
4-141827	JP document	5-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

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Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1,2,7,9,11,12,17 and 19 are rejected under 35 U.S.C. 103. (a) as being unpatentable over the acknowledged prior art JP 4-141827 further considered with Moriya et al.

The acknowledged prior art discloses a basic parameter testing/calibrating capability wherein the parameter selected is one of power, which is equivalent to intensity.

The acknowledged prior art lacks any mention of a spiral track environment and that information can be recorded on/in all areas.

Such a capability is well known as taught by Moriya et al.

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It would have been obvious to one of ordinary skill in the art to modify the system of the above noted JP prior art system with the teaching from Moriya et al, motivation is to use the above parameter setting ability with as many different types of records as possible, and hence increase the overall system use.

The limitations of claim 2 are considered self- evident.

For claims 7 & 17, intensity is interpreted as power.

The limitations of claims 9 and 19 are considered inherently present in Moriya et al and no further analysis is made.

Applicants' arguments/amendments have been considered but are not deemed persuasive because as interpreted by the examiner - see col. 12 lines 35-55 the recording technique described therein meets the claimed invention.

3. Claims 3 and 13 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the art as applied to claims 1,2,11 and 12 above and further considered with the acknowledged prior art.

Applicants' have admitted that such a capability is well known in the art – see page 29 of the disclosure. No further rebuttal is deemed necessary.

4. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of Johann et al.

The ability of establishing an average of a parameter is considered well known as taught by the Johann et al reference.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability of the references as relied upon with respect to the parent claim with the teaching from Johann et al, motivation is to obtain a better optimization parameter.

5. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

Again, the limitations of claims 5 and 15 are acknowledged as being well known by applicants, see page 29 of the specification. Use thereof in the overall system is considered to be obvious to one of

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ordinary skill in the art, motivation is to perform the parameter calibration/optimization technique in an acknowledged system.

6. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3 and 13 above, and further in view of the acknowledged prior art.

Applicants have acknowledged the prior art on page 29 of the specification referring to the ability to perform the optimization/calibration at separate times/locations. Hence the examiner interprets the claim limitation "are performed at two positions spaced apart" as having been met. Additionally, due to the spiral track layout of Moriya et al, the ability of having information on both the lands and the grooves inherently meets the above language as well.

7. Claims 8,10,18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Pietrzykoski et al.

The ability of having a plurality of parameters optimized is considered merely a duplication of effort as taught by Pietrzykoski et al, which teach the optimization for a plurality of parameters in this environment.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimization/establishing capability found in the above system with respect to the parent claim with the additional capability of doing so for a plurality of parameters as taught by Pietrzykoski et al, motivation is to perform such optimization techniques on as many parameters in the system that require correction and hence improve the overall system response.

Furthermore, Pietrzykoski et al discuss symmetry – see column 10 line 8 plus as one of those parameters.

In the above rejections, the examiner notes that claims 11 –20 are methods which parallel the apparatus limitations as found in claims 1 – 10. The examiner considers the method limitations to be met when the system is operational.

✓ 8. Claims 1,2,7,9,11,12,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art JP 4-141827 considered with Moriya et al and both further considered with Nakane et al (any of the patents - 6091669, 5936932, or 5946285).

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JP 4-141827 and Moriya et al are relied upon for the reasons stated in paragraph 2 above.

Applicants' arguments imply that the recording capability of Moriya et al is somehow not continuously. If applicants' could positively distinguish there over it would appear that the format applicants' are attempting to define is that known in the art as SS-L/G.

This format is known as taught by any of the patent to Nakane et al.

It would have been obvious to one of ordinary skill in the art to modify the above system of JP 4-141,827 & Moriya et al with the additional format teaching from any of the Nakane et al references, motivation is to reduce unnecessary "jumping time" and hence increase operational efficiency.

9. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,2,11 and 12 above, and further in view of the acknowledged prior art.

The additional limitations of these claims are acknowledged to be well known in the art as stated on page 29 of the disclosure.

Whether one uses the above system with the acknowledged prior art is considered obvious to one of ordinary skill in the art, motivation is to take advantage of prior systems and hence increase the operability range (usage) of the parameter setting/calibrating technique.

10. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of Johann et al.

The ability of establishing an average of a parameter is considered to be well known as taught by the Johann et al reference.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability and further modify it with the "averaging" capability of Johann et al, motivation is to obtain a better optimization parameter.

11. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

The limitations of claims 5 & 15 are acknowledged as being well known – see page 29 of the specification.

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It would have been obvious to one of ordinary skill in the art to modify the basic optimization/calibration capability of the above references with the teaching from the acknowledged prior art, motivation is to perform the parameter calibration/optimization technique in an acknowledged system.

12. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of the acknowledged prior art.

Applicants' have acknowledged the prior art on page 29 of the specification, referring to the ability to perform the optimization/calibration at separate times/locations. Hence the examiner interprets the claim limitations "are performed at two positions spaced apart" as having been met. Additionally, due to the spiral track layout of Moriya et al, the ability of having information on both the lands and the grooves inherently meets the above language as well.

13. Claims 8,10,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Pietrzykoski et al.

The ability of having a plurality of parameters optimized is considered a duplication of effort as taught by Pietrzykoski et al.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability with the additional capability for doing so for a plurality of parameters as taught by Pietrzykoski et al, motivation is to perform such optimization techniques on as many parameters identifiable in the system that require correction and hence improve the overall system response.

(11) Response to Argument

With respect to appellants' arguments on pages 5 –10 of his Brief that neither reference the JP 4-141827 and Moriya et al reference render claims 1, 2, 11, and 12 as obvious the examiner respectfully disagrees.

The JP document was not relied upon for teaching/disclosing a continuous (recording on both land and groove tracks) recording or reproducing capability.

Moriya et al does disclose a continuous recording or reproducing ability – recording/reproducing continuously on both the land and groove track as detailed in column 13 lines 35 to 55.

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Hence, the examiner considers such an ability to be present in Moriya et al.

That the Moriya et al reference does not disclose/teach the setting and control of system parameters is not germane because it was not relied upon for such a capability, as acknowledged by the examiner in the above rejection.

That the JP document fails to teach setting or changing a control parameter as claimed is incorrect. As summarized on pages 8 - 10 (starting at the paragraph entitled "MEANS of Solving the Problems and ending with the first full paragraph of page 10) of the attached English translation of JP 4-141,827, minimum values (of the laser power) are indeed set/established and subsequent system operations permit the changing of the system parameters to optimize this quality of the system. As best understood from the English translation of the JP document and as admitted by appellants, control parameters are obtained for the land and groove tracks – see page 6 lines 8 –10 of the Brief.

Appellants continue to argue that this prior art requires repeating the recording and reproduction process for each land and groove track separately. This is believed to be a function that the checking of the parameter values is done at the end of each track segment/function, i.e., at the end of recording/reproducing each land or groove segment.

The Moriya et al reference teaches that the recording of information continuously on both land and groove tracks can be accomplished, see column 12 lines 35 – 55.

Hence the examiner in viewing the claimed limitations as a whole and the above teaching concludes that one of ordinary skill in the art would be able to meet the above claimed limitations by having the control parameters changed at the end of the recording/reproducing session when one comes to the end of the continuous recording/reproducing of the land – groove track, and not at the end of each segment.

With respect to the argument that a longer time and more effort is required and that separate optimum focus positions for a land and groove track is required is not germane to the claimed limitations, since such limitations are not present.

With respect to the argument re claim 12, the examiner respectfully disagrees. As stated on page 6 of the Office action dated March 30, 2000 and maintained in the FINAL rejection, the functional

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limitations (because claims 11 and 12 are method claims) are met when the above system of JP 4-141,827 & Moriya et al operate.

With respect to appellants' arguments on page 10 –11 that claims 7 and 17 are patentably distinct over the art of record, the examiner respectfully disagrees.

The examiner has interpreted claims 7 and 17 to define a control parameter as an intensity of the laser beam. As noted on pages 17 plus with respect to the description of figures 4 & 5 therein, a reproduction signal quality discriminating circuit (6) is relied/used. Since appellants' disclosure refers to signal quality detector 4 – see page 36 of their disclosure, the examiner has concluded that such elements are similar (if not identical). Comparing this disclosure with appellants' disclosure on pages 36 lines 6 - 14 and page 48 lines 22, the examiner concludes that the intensity level limitation of claim 7 is indeed controlled, corrected for in the JP document as well. Hence because the power level is controlled the intensity of the laser beam controlled as well as required by the claimed limitations.

With respect to appellants' arguments on page 10 to claim 2, the examiner respectfully disagrees.

The claim requires that a control parameter is common to both the groove and land track. Because control parameters are provided for in the JP document and the overall combination provides for recording or reproducing the continuous land-groove track, it necessarily follows that the control parameter is common to both, since both (land – groove) are recording/reproduced continuously.

With respect to appellants' arguments on page 10 re claim 12, the examiner respectfully disagrees. The examiner has interpreted the limitations of claim 12 to be functional (method claims) and present as the above system of JP 4-141,827 operates.

With respect to appellants' arguments on page 11 re claims 9 and 19, the examiner respectfully disagrees. The limitations thereof require that the number of sectors of groove tracks to be recorded is equal in number of sectors of lands tracks to be recorded is believed inherent in the above documents. Appellants' attention is drawn to the description of sectors and land – grooves in Moriya et al. Because every spiral track is composed of a land and groove (in example 1 of Moriya et al for instance), then it must follow that for every land track there is a groove track, and that for each sector having a spiral track

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the numbers of each are equal. Hence the examiner maintains his position that such a limitation is indeed inherently present in the combination of references.

With respect to appellants' arguments on pages 11- 12 that the combination of references relied upon do not meet the claimed limitations, the examiner respectfully disagrees.

This combination of references adds any of the references to Nakane et al in teaching the particular type of SS – L/G recording format.

Appellants' argument that the claims are not attempting to define what is known as SS-L/G format. The examiner nevertheless believes that the claim breadth permits the examiner to so interpret the continuous recording in both the land and groove track limitation. Hence this rejection although maintained, only differs from the rejection based on only the JP 4-141827 & Morita et al combination on this additional point. The same arguments with respect to the elements claimed as stated above are repeated hereat.

With respect to appellants' arguments on pages 13 – 15 that the limitations of claims 3-6,8,10,13-16, 18 and 20 is incorrect, the examiner respectfully disagrees.

The secondary references to Johann et al and Pietrzykoski et al are not relied upon for teaching the continuously recording in both land and groove segments/tracks. These secondary references are relied upon for the reasons stated in the FINAL rejection (see above). Again, the examiner considers the continuously recording in both the land track and groove track to be taught in the Moriya et al reference or alternatively as indicated the SS L/G recording format found in any of the Nakane et al references.

With respect to appellants' arguments that claims 3 and 13 are patentable because unspecified acknowledged prior art was cited, the examiner respectfully disagrees.

The examiner, in his FINAL rejection indicated that the "acknowledged prior art" is what is found in appellants' own disclosure at page 29. Reading page 29 with the limitations of claims 3 and 13 in mind, the last paragraph refers to obtaining such control parameters separately in a conventional apparatus. Hence, the examiner concludes that appellants' are well aware of such a limitation in conventional apparatus, and that these conventional apparatus are what the examiner has called the acknowledged prior art.

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With respect to appellants' arguments on pages 15 – 18 that the examiner has failed to point out any teaching or suggestion by which a person of ordinary skill in the art would know or would be motivated to select the particular features of Appellants' claimed invention from the various features of the cited references, the examiner respectfully disagrees.

The examiner has endeavored to supply a reason or motivation for combining the references in the above rejections. Appellants' can disagree with such motivation, but the examiner has not failed to supply one. Nor has the examiner failed to point out what feature he is combining, or relying upon in order to meet the claimed limitations.

With respect to the arguments at page 18 re the insufficient disclosure rejection, because such a position is no longer maintained, no response is considered necessary.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Aristotellis M. Psinos

Primary Examiner

AU 2651

AMP

Sept 4, 2001]

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